

## **REMARKS**

### **Amendments**

Except as expressly discussed below, any changes made to the application are not made in reply to any rejection or other communication from the Examiner, but are made solely to improve the clarity, readability, or understanding of the application or the portion of the application changed. No amendment was made to add new matter or narrow the scope of the claims. Indeed, all amendments were made merely as cosmetic amendments to improve the readability and coherence of the resulting patent.

### **Status of Prosecution**

Applicant filed the original application on February 12, 2002. The Examiner mailed a non-final office action on April 21, 2005. This paper is in Reply to that office action. Applicant requests reconsideration and withdrawal of the rejections raised in that office action.

Claims 1-46 are pending. The Examiner rejected claims 1-46.

### **Examiner's General Objections and Rejections**

On page 2 of the Office Action the Examiner required a change in the title of the invention and implied that an amendment of the abstract would be appropriate. In reply, Applicant states that the Examiner's statements are not properly characterized as rejections under 35 U.S.C. §112, but as objections. Applicant has, however, revised the abstract, and amended the title, as shown in the amendments to the specification above.

On pages 2-4 the Examiner rejected claims 1, 8, 9, 11, 16, 18, 22, 26, 33, 39, 41 and 43 under 35 U.S.C. §112, second paragraph. Applicant respectfully traverses the §112 rejections as further amplified in the Remarks section of this paper.

On pages 4-11 the Examiner rejected claims 1-8, 10-11, 13-14, 16-17, 19-20, 31, 33, 35 and 37 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,698,021 issued on February 24, 2004 to Amini *et al.* ("Amini Patent"), an argument Applicant respectfully traverses.

On pages 11-13 the Examiner rejected claims 24, 26-28 and 30 under 35 U.S.C. §103(a), as being unpatentable over the Amini Patent in view of an electronic article described as "Fickes," an argument that Applicant respectfully traverses.

On page 14 the Examiner rejected claims 25 and 29 under 35 U.S.C. §103(a), as being unpatentable over the Amini Patent and Fickes, in further view of U.S. Patent No. 6,011,579 issued on January 4, 2000 to Newlin ("Newlin Patent"), an argument that Applicant respectfully traverses.

On pages 15-18 the Examiner rejected claims 9, 12, 15, 18, 21-23, 32, 34, 36, and 38-46 over the Amini Patent in view of the Newlin Patent, an argument that Applicant respectfully traverses.

Applicant respectfully urges, therefore, that the rejections of the Examiner be withdrawn.

#### **Rejections Under 35 U.S.C. §112**

##### **"Independent," "Integrated," and "Centralized"**

On page 3 of the Office Action the Examiner asserts that the terms "independent" and "integrated" and "centralized" are contradictory. Applicant respectfully disagrees, and traverses the rejections as arising under 35 U.S.C. §112.

The term "independent," as shown in the attached sheets included collectively with this Reply as **Exhibit A**, comprising extracts from the Merriam-Webster Dictionary (electronic version), means at least that the system does not require or rely on other systems. The term "integrated" includes the meaning that the components of the system are "formed, coordinated, or blended into a functioning or unified whole." The term "centralized" means to "consolidate," and in the context of the application the specification provides that "...as also shown in Figures 1 and 3, a hub 21 is provided. In a preferred embodiment of the present invention, hub 21 is an Ethernet switch or switches. Use of an Ethernet switch is, however, not a limitation on the present invention, and hub 21 may include one or more variations of switches, including fibre channel switches (not shown)."

##### **"High Speed"**

The term "high speed" means at least what is disclosed in the specification of the application, namely that the system provides "data management capable of managing data, including surveillance information, in substantially real time." See Application, page 6, lines 7-11. The specification also indicates that the system provides "at least the capability to transmit data at significantly higher speeds than current systems provide." See Application, page 6, lines 18-19.

The Examiner's comments on page 3 of the Office Action about the term "high speed," and Applicant's replies, should also be reconsidered in view of Applicant's following comments about hindsight. Thus, as shown in extracts from *Newton's Telecom Dictionary* attached as **Exhibit B**, a person skilled in the art will appreciate that the term "high speed" (in conjunction with the term "broadband") are terms that had a technological meaning at the time the invention was made, have a meaning today, and may have yet another meaning tomorrow, due to the speed at which technology changes. Thus, for example, the Examiner suggests that the terms "high speed" and "broadband" or the terms "high speed" and "without broadband" involve the questions of a dialup connection of 56kbps. (See last line, page 3, Office Action.) According to *Newton's Telecom Dictionary*, however, "[today's common definition of broadband is any circuit significantly faster than a dialup phone line...[so that] the term 'broadband' can mean anything you want it to be so long as it's 'fast.'" See *Newton's Telecom Dictionary*, page 126, emphasis added. Likewise, the term "high speed" is a term also recognized by one skilled in the art. For example, the words "high speed" in conjunction with the words "local network" means "high throughput." A "high speed signal" is one "traveling at a DS-3 rate of 44.736 MBPS...or at either 90 Mbps or 180 Mbps (Optical mode)." See *Newton's Telecom Dictionary*, page 393.

While not required by any rejection of the Examiner, Applicant has amended the claims of the application by deleting references to seven (7) frames per second.

Accordingly, the Examiner's rejections of those terms under 35 U.S.C. §112 should be withdrawn.

#### **A Special Note About Hindsight**

The remarks above, and the fact that the system shown and claimed in the application has the capability of transmitting data "at significantly higher speeds than current systems provide," also suggests it would be appropriate to include a comment normally associated with discussions of rejections under 35 U.S.C. §103: Hindsight is impermissible, and for good reasons.

Through no fault of Applicant, through no fault of the Examiner, almost four (4) years passed between conception of the invention and mailing of the office action. In this field of art, that is an inordinately long time. Innovation continues at dizzying speeds. For those involved in the art of telecommunications, it is difficult to un-ring the proverbial bell: it is hard to remember how little was known or suggested when the subject matter of the application was invented. It is

difficult to appreciate how innovative were the concepts disclosed and claimed in the application at the time of invention. Accordingly, Applicant respectfully requests that the Examiner, who obviously is learned in the field of his art, to reassess some of the rejections in view of *why* hindsight is impermissible.

As the Examiner knows, many cases suggest not only the rule that hindsight is inappropriate, but more importantly explain *why* hindsight is inappropriate. Examples include *In re Debiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999); *Ecolchem, Inc. v. Southern California Edison Company*, Fed. Cir. No. 99-1043, September 7, 2000; *In re Sang-su Lee*, 277 F.3d at 1344, 61 USPQ2d at 1434-1435 (CAFC, 2002). These cases remind us that obviousness must not be viewed retrospectively, but solely "at the time the invention was made." *In re Debiczak*, 50 USPQ2d 1614 at 1617, citing 35 U.S.C. §103.

As the Federal Circuit observed:

Measuring a claimed invention against the standard established by section 103 requires the oft-difficult but critical step of casting the mind back to the time of the invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field... Close adherence to this methodology is especially important in the case of less technologically complex inventions, where the very ease with which the invention can be understood may prompt one to "fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against the teacher."

*In re Debiczak*, 50 USPQ2d 1614 at 1617.

#### **"Substantially"**

The Examiner stated at page 3 of the Office Action that the term "substantially" as used in claims 8, 9, 11, 16, 18, 26, 33, 39, 41 and 43 appear unclear. Applicant respectfully disagrees, and traverses the rejection under 35 U.S.C. §112.

The following comments also apply to all rejections by the Examiner under 35 U.S.C. §112.

§112/2, requires that a specification conclude with one or more claims "particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention." The Federal Circuit has held that for a claim to comply with § 112/2, "it must satisfy two requirements: it must set forth what 'the applicant regards as his invention,' and second, it

must do so with sufficient particularity and distinctness, *i.e.*, the claim must be sufficiently 'definite.'" *Solomon v. Kimberly-Clark Corp.*, 216 F.3d 1372 (Fed. Cir. 2000).

A claim, however, is not necessarily "indefinite" even if it is hard to understand. Claims also are not indefinite because the claims are difficult to construe or because witnesses and courts may disagree on how the claims should be construed. *Exxon Research & Eng'g Co. v. United States*, 265 F.3d 1371, 1375 (Fed. Cir. 2001). Indeed, the Federal Circuit recently held that a claim is not necessarily indefinite unless it is "insolubly ambiguous." *Honeywell Int'l, Inc. v. United States Int'l Trade Comm'n*, 341 F.3d 1332 (Fed. Cir. 2003).

The Federal Circuit also has held that the "requirement that the claims 'particularly point out and distinctly claim' the invention is met when a person experienced in the field of the invention would understand the scope of the subject matter that is patented when the claim is read in conjunction with the rest of the specification. 'If the claims when read in light of the specification reasonably apprise those skilled in the art of the scope of the invention, §112 demands no more.'" *S3 Inc. v. nVIDIA Corp.*, 259 F.3d 1364, 1367 (Fed. Cir. 2001).

As to the word "substantially," the Federal Circuit, in a decision issued March 7, 2005, held that the term "substantially" is a "meaningful modifier implying 'approximate' rather than 'perfect.'" *Playtex Products, Inc. v. Proctor & Gamble Company, et al.*, (Fed. Cir., decision 04-1200, 2005) at page 11 of the slip opinion. The Court noted that in earlier decisions it had refused "to impose a precise numeric constraint" on a term that included "substantially," noting that the word is just one of a variety of words "of approximation, such as 'generally' and 'substantially,' [that] are descriptive terms 'commonly used in patent claims to avoid a strict numerical boundary to a specific parameter.'" *Playtex Products*, citing *Cordis Corp. v. Medtronics AVE, Inc.*, 339 F.3d 1352, 1361 (Fed. Cir. 2003) and *Anchor Wall Sys. V. Rockwood Retaining Walls, Inc.*, 340 F.3d 1298 (Fed. Cir. 2003).

The word "substantially" also has been approved expressly as noted in MPEP §2173.05(b) as a term often used in conjunction with another term to describe a particular characteristic. It is considered a broad term held to be definite. Thus, for example, dependent claim 8 is directed to "one or more data acquisition devices...equipped to substantially simultaneously record and transmit the data." Thus from a temporal view, data acquisition devices need not be capable of simultaneously both recording and transmitting data, but only

substantially simultaneously. Likewise, for example, dependent claim 11 is directed to “one or more cameras...equipped to substantially simultaneously record visual information from more than one node on the system.” Again, the recording of visual information need not occur precisely simultaneously, but only substantially simultaneously. The word “substantially” is used similarly in the remaining claims rejected by the Examiner for including “substantially.”

#### **Negative Limitation**

On page 3 of the Office Action the Examiner asserts, among other arguments, that independent claim 16 includes a negative limitation. To the extent that Applicant understands the basis for the rejection as set forth by the Examiner, it is first noted that negative limitations are now perfectly acceptable. As stated succinctly in the MPEP, the “current view of the courts is that there is nothing inherently ambiguous or uncertain about a negative limitation.” See MPEP §2173.05(j).

Applicant also has amended claim 16, among others, as shown in the Listing of Claims, to delete reference to seven frames per second. Accordingly, the remaining comments of the Examiner are now moot.

#### **“Human Usable Format”**

On page 4 of the Office Action the Examiner suggests that “human usable format” in claim 22 is unclear. Applicant presumes that the Examiner intended to address claim 23 rather than claim 22. In a similar distinction between computer programs identified as written in machine language (object code) and programming language (source code), “human usable format” is intended to indicate that the software presents the data in a format that is at least readable by humans.

Applicant respectfully urges, therefore, that all rejections under 35 U.S.C. §112 be withdrawn.

#### **Rejections Under 35 U.S.C. §102(e)**

On pages 4-11 the Examiner rejected claims 1-8, 10-11, 13-14, 16-17, 19-20, 31, 33, 35 and 37 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,698,021 issued on February 24, 2004 to Amini *et al.* (“Amini Patent”) an argument Applicant respectfully traverses.

35 U.S.C. §102 (e), as revised, and cited by the Examiner as the basis for rejection of independent claims 1, 16, 31, and 35, and the related dependent claims, provides:

“A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.”

Applicant submits that the Amini Patent does not satisfy the “all-elements” rule of MPEP §2131, which provides:

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference...The identical invention must be shown in as complete detail as contained in the claim...[and] the elements must be arranged as required in the claim. (Emphasis added)

While the reference includes words used by Applicant to describe elements of the apparatus in the Amini Patent, the use of similar words is not determinative. The words in the reference describe apparatus structure, and cooperation of structure, that are different than those disclosed in the Application. MPEP §2111.01 clearly requires that “...pending claims must be given their broadest reasonable interpretation consistent with the specification.” Accordingly, while the terms used to describe various elements are similar, the terms describe structural components that cooperate in completely different ways. Terms must be viewed “in light of the specification.”

Contrary to the Examiner’s argument that all elements are disclosed in the Amini Patent, a system that is independent and integrated is not, so the rejection of at least independent claims 1, 16, 31, and 35 is unsupported, and therefore should be withdrawn.

In addition, contrary to the Examiner’s argument that all elements are disclosed in the Amini Patent, a system for providing high speed transmittal of audio, visual, telephony and other data across the network is not, so the rejection of at least independent claims 1, 16, 31, and 35 is unsupported, and therefore should be withdrawn. See application, page 2, lines 1-9.

Also contrary to the Examiner's argument that all elements are disclosed in the Amini Patent, a system capable of accumulating surveillance information from at least one surveillance data acquisition device is not, so the rejection of at least independent claim 31 should be withdrawn.

Also contrary to the Examiner's argument that all elements are disclosed in the Amini Patent, a system capable of routing the surveillance information to one or more subsystems for data storage is not, so the rejection of at least independent claim 31 should be withdrawn.

Also contrary to the Examiner's argument that all elements are disclosed in the Amini Patent, a system capable of updating the surveillance information, analyzing surveillance information, reporting the surveillance information on demand, providing telephonic communications across the at least one independent data transmission system, and continually repeating at least those steps is not, so the rejection of at least independent claim 31 should be withdrawn.

Also contrary to the Examiner's argument that all elements are disclosed in the Amini Patent, a system "including a plurality of devices interconnectable with the independent data transmission system capable of...(3) routing the surveillance information to one or more subsystems for data storage" is not shown or claimed in the Amini Patent, and therefore any rejection of claim 31 on any basis should be withdrawn.

Also contrary to the Examiner's argument that all elements are disclosed in the Amini Patent, the camera and other devices shown and claimed in the application are capable of performing analyses, while the video device shown in the Amini Patent are connected strictly to the server (see Amini Patent, Fig. 4), and are analogue, rather than digital.

Also contrary to the Examiner's argument that all elements are disclosed in the Amini Patent, a system that includes at least one high speed network for transmitting the digital data is not, so the rejection of at least independent claim 35 should be withdrawn.

For those structural reasons, and for the reasons articulated below under "Discussions of Rejections under §102," Applicant respectfully requests that the rejection be withdrawn.

#### **Discussion of Rejections under 35 U.S.C. §102**

For fundamental teaching on the doctrine of anticipation, one must consider the decision of Judge Rich in *In re William J. King*, 801 F.2d 1324, 231 USPQ 136 (Fed. Cir. 1986):



It is axiomatic that anticipation of a claim under § 102 can be found only if the prior art reference discloses every element of the claim, and that anticipation is a fact question subject to review under the clearly erroneous standard. *Lindemann Maschinenfabrik v. American Hoist and Derrick*, 730 F.2d 1452, 1457, 221 U.S.P.Q. 481, 485 (Fed. Cir. 1984). Our review of a finding of anticipation is the same whether it was made by the board or by a district court.

*In re William J. King* at 231 USPQ 139 (emphasis added).

Further, for a reference to anticipate a claim under 35 U.S.C. §102, that reference must teach, or identically describe, each and every element or step of the claim in the identical orientation. *Atlas Powder v. E.I. duPont*, 750 F.2d 1569, 224 USPQ 409 (Fed. Cir. 1984); *Jamesbury Corp. v. Litton Industrial Products*, 756 F.2d 1556, 225 USPQ 253 (Fed. Cir. 1985) (emphasis added). “Anticipation” is a restrictive concept, requiring the presence in a single prior art disclosure of each and every element of a claimed invention. The test for infringement by anticipation should be rephrased as, “That which would *literally* infringe if later in time anticipates if earlier than the date of invention.” (Emphasis in the original) See also *Lewmar Marine, Inc. v. Barient, Inc.*, 827 F.2d 744, 3 USPQ2d 1766 (Fed. Cir. 1987). Further, as held in *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927 F.2d 1565, 18 USPQ2d 1001, 18 USPQ2d 1896 (Fed. Cir. 1991), “there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention.” (Emphasis added.) As discussed above, the Reference does not disclose the identical structure and cooperation of structure as described in the Application examined by the Examiner. *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 218 USPQ 781 (Fed. Cir. 1983).

Therefore, Applicant respectfully urges that the cited reference does not anticipate Applicant's invention as claimed, and that the rejections be withdrawn.

#### **First Rejection under 35 U.S.C. §103(a)**

On pages 11-13 the Examiner rejected independent claim 24, and dependent claims 26-28 and 30 under 35 U.S.C. §103(a), as being unpatentable, or obvious, over the Amini Patent in view of an electronic article described as “Fickes,” an argument that Applicant respectfully traverses.

35 U.S.C. §103 provides:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Applicant respectfully submits, however, that the differences between the subject matter sought to be patented, and the references cited by the Examiner, are not such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains.

Applicant adopts and incorporates by reference the arguments made in connection with the rejections under 35 U.S.C. §102 above.

Moreover, as stated in the MPEP, to establish a *prima facie* case of obviousness three basic criteria must be satisfied: (1) a suggestion or motivation to modify the cited reference or to combine the teachings in the cited references; (2) a reasonable expectation of success; and (3) the cited references must teach or suggest all the claim limitations. See MPEP §706.02(j). The cited reference “must expressly or impliedly suggest the claimed invention....”

As also provided in MPEP §2143.01, the “mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.”

Also, “most if not all inventions arise from a combination of old elements...Thus, every element of a claimed invention may often be found in the prior art. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. Rather, there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by applicant.” See *In re Kotzab*, 217 F.3d 1365, 55 USPQ2d 1313 (Fed. Cir. 2000).

Further, references cannot be modified or combined if their function is destroyed. See MPEP §2143.01. If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.

In addition, Applicant's disclosure should not be used as a blueprint to reconstruct the claimed coupler out of isolated teachings in the prior art. Hindsight, in other words, as earlier emphasized, is impermissible. *Grain Processing Corp. v. American Maize-Products*, 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988).

Additionally, all claim limitations must be considered, especially when missing from the alleged prior art. That is because 35 U.S.C. §103 is concerned with differences between the subject matter sought to be patented, and the alleged prior art, with the subject matter sought to be patented viewed as a whole. *In re Fine*, 873 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). In addition to reminding that retrospective findings of obviousness are impermissible, the cases also require proof, actual evidence, to support an obviousness rejection.

The Federal Circuit has emphasized that evidence must support the assertion of a suggestion, teaching, or motivation; if there is no evidence of such a suggestion, teaching, or motivation, it is inappropriate to "make the inventor's disclosure a blueprint for piecing together the prior art to defeat patentability -- the essence of hindsight. Broad conclusory statements regarding the teaching of multiple references, standing alone, are not "evidence." *In re Debiczak*, 50 USPQ2d 1614 at 1617. The evidence, in other words, must show a "skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed." *Ecolochem, Inc. v. Southern California Edison Company*, at page 11, quoting *In re Rouffet*, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998). The Court also emphasized the proof standard by confirming that "[A] rejection cannot be predicated on the mere identification...of individual components of claimed inventions. Rather, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed." *Ecolochem, Inc. v. Southern California Edison Company*, at page 11, quoting *In re Werner Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000).

#### **The Cited References**

Regarding the base, or primary, reference, namely the Amini Patent, the Applicant already has shown that one of the elements of a *prima facie* case of obviousness, that the cited reference "must expressly or impliedly suggest the claimed invention....," has not been

established by the Examiner. Nothing in the secondary reference, or Fickes, shows the slightest motivation, suggestion, or teaching of the desirability of making the specific combination made by applicant. At most, Fickes discussed merely the use of a remote monitoring system, with no specifics.

Applicant also notes that the Fickes article is simply that, apparently a news article, not an extract from a learned treatise. The inductive arguments the Examiner seeks to make from that article are hearsay, not self-authenticating, have no probative value, and should be accorded no relevancy in connection with the examination of the application, and certainly not to support the truth of the Examiner's arguments.

The application of Applicant is expressly directed to a private system. For example, independent claim 1 is directed to "an independent and integrated centralized high speed system for data management...[that includes]... a private data processing center interconnectable with the one or more data acquisition devices, and means for transmitting the data across the system, for managing the data." (Emphasis added.) None of the references cited for rejection under 35 U.S.C. §103, including the Amini Patent, are directed to a private system, and at least for that reason all rejections for "obviousness" should be withdrawn.

Accordingly, the Examiner has not made a prima facie showing of obviousness, and the rejections of claims therefore should be withdrawn.

#### **Second Rejection under 35 U.S.C. §103(a)**

On page 14 the Examiner rejected claims 25 and 29 under 35 U.S.C. §103(a), as being unpatentable over the Amini Patent and Fickes, in further view of U.S. Patent No. 6,011,579 issued on January 4, 2000 to Newlin ("Newlin Patent"), an argument that Applicant respectfully traverses.

35 U.S.C. §103 provides:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Applicant respectfully submits, however, that the differences between the subject matter sought to be patented, and the references cited by the Examiner, are not such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains.

Applicant adopts and incorporates by reference the arguments made in connection with the rejections under 35 U.S.C. §102 and §103 above.

Regarding the base, or primary, reference, namely the Amini Patent, the Applicant already has shown that one of the elements of a *prima facie* case of obviousness, that the cited reference “must expressly or impliedly suggest the claimed invention.....,” has not been established by the Examiner. Nothing in the secondary reference, or Fickes, shows the slightest motivation, suggestion, or teaching of the desirability of making the specific combination made by applicant.

Applicant also notes that the Fickes article is simply that, apparently a news article, not an extract from a learned treatise. The inductive arguments the Examiner seeks to make from that article are hearsay, not self-authenticating, have no probative value, and should be accorded no relevancy in connection with the examination of the application, and certainly not to support the truth of the Examiner’s arguments.

Because neither the primary reference nor the secondary reference support a *prima facie* showing of obviousness, the tertiary reference can have no more validity in supporting the Examiner’s arguments.

Accordingly, the Examiner has not made a *prima facie* showing of obviousness, and the rejections of claims therefore should be withdrawn.

### **Third Rejection under 35 U.S.C. §103(a)**

On pages 15-18 the Examiner rejected claims 9, 12, 15, 18, 21-23, 32, 34, 36, and 38-46 over the Amini Patent in view of the Newlin Patent, an argument that Applicant respectfully traverses.

Applicant respectfully submits, however, that the differences between the subject matter sought to be patented, and the references cited by the Examiner, are not such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains.

Applicant adopts and incorporates by reference the arguments made in connection with the rejections under 35 U.S.C. §102 and §103 above.

Regarding the base, or primary, reference, namely the Amini Patent, the Applicant already has shown that one of the elements of a *prima facie* case of obviousness, that the cited reference "must expressly or impliedly suggest the claimed invention....," has not been established by the Examiner. Nothing in the secondary reference, or the Newlin Patent, shows the slightest motivation, suggestion, or teaching of the desirability of making the specific combination made by applicant.

Because the primary reference does not meet the requirements necessary to establish a *prima facie* case of obviousness, the secondary reference can have no more validity in supporting the Examiner's arguments.

The Newlin Patent also is directed to analogue telephone sets, unlike the digital audio and video components of the application. See Newlin Patent, Figure 3. Accordingly, the Newlin Patent would not disclose a high speed system.

Accordingly, the Examiner has not made a *prima facie* showing of obviousness, and the rejections of claims therefore should be withdrawn.

#### **Conclusions**

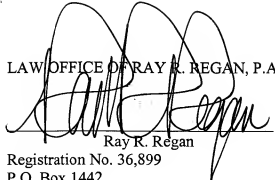
For the reasons set forth above, Applicant respectfully requests reconsideration and withdrawal of the rejection of all claims.

The remaining references cited by the Examiner, but not relied on for the rejection of claims, have been noted. Because the remaining references are no more pertinent than the applied references, a detailed discussion of these remaining references is deemed unnecessary for a full and complete Reply to the Office Action.

In conclusion, Applicant respectfully asserts that this Reply is complete as contemplated in 37 CFR §1.111, that claims are patentable for the reasons set forth above, and that the Application is now in condition for allowance. Accordingly, Applicant respectfully requests an early notice of allowance. The Examiner is requested to call the undersigned at (505) 897-7200 for any reason that would advance the instant application to issue.

Respectfully submitted,

LAW OFFICE OF RAY R. REGAN, P.A.



Ray R. Regan  
Registration No. 36,899  
P.O. Box 1442  
Corrales, New Mexico 87048  
Telephone (505) 897-7200  
Facsimile (505) 897-7201  
E-mail [rayregan@rayregan.com](mailto:rayregan@rayregan.com)

**Exhibit A and Exhibit B Follow**